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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,855	08/19/2003	Jurgen Kocher	CH-7778/LcA 36,078	6310

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/643,855	<b>Applicant(s)</b> KOCHER, JURGEN	
	<b>Examiner</b> Brian J. Davis	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 12-16 is/are allowed.
- 6) ☒ Claim(s) 10,17 is/are rejected.
- 7) ☒ Claim(s) 9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/19/03; 6/21/04</u> | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION*****Election/Restriction***

The examiner acknowledges applicant's election, with traverse, of the compound when, using the variables of formula I:  $R^1=R^3=H$ ;  $R^2=R^4=Ph$ ; and  $R^5=R^6=COOC_2H_5$ .

Applicant argues that the instant compounds are not patentably distinct. The examiner respectfully disagrees. As was pointed out in the original election/restriction requirement, the instant claims are drawn to several large, broad classes of compounds, for instance, when  $R^5=COOR^7$  and  $PO(OR^{10})_2$ . These are structurally and patentably distinct sets of compounds. This is reflect in their different classifications (560 and 564 [since the amine group, in the latter case has precedence], respectively.

The election/restriction was proper for reasons of record and was made in order to facilitate the reasonably complete and thorough search to which applicant is entitled and is hereby made FINAL.

***Information Disclosure Statement***

Two references on the IDSs have been lined-through. In one instance the publication number is invalid, and in the other the listed reference is a duplicate.

***Specification***

The disclosure is objected to because of the following informalities: The use of a trademark (in the examples) has been noted in this application. Due to the fact that a

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trademark is a product name and the formulation/content etc. of a trademarked product may change over time - due to market and/or technological influences, for instance - trademarks must always be accompanied by the corresponding generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Appropriate correction is required.

### ***Claim Objections***

Claims 9 and 11 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may depend from any preceding claims in the alternate only. See MPEP § 608.01(n). Normally, the claims would not be further treated on the merits, but, in order to advance the prosecution, they have been so treated.

### ***Claim Rejections - 35 USC § 112, FIRST PARAGRAPH***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A description of the process and the definition of the compounds described as pharmaceuticals and agrochemicals, critical or essential to the

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practice of the invention of claim 17, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). It is essential in a chemical process to know what the process is and what are the desired products. The disclosure is silent as to what are such products or processes.

***Claim Rejections - 35 USC § 112, SECOND PARAGRAPH***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact meaning of the phrase "...a reducing agent is further in the reaction" is unclear.

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: what exactly are the process steps for preparing pharmaceutical and agrochemicals – which themselves are undefined.

***Allowable Subject Matter***

The elected species has been searched and is deemed free of the prior art. The search was therefore expanded as called for under current Office Markush practice, a

compound-by-compound search. This resulted in all remaining species being searched and also deemed free of the prior art.

Claims 1-8 and 12-16 are allowed. Claims 9-11 would be allowed once the objections and 112 rejections outlined above have been overcome. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be US 6,392,103, cited by applicant in the IDS, which generically teaches ligands structurally related to those of the instant invention (compound IV column 5 line 15). The cited prior art neither teaches nor suggests the instant ligands, however. Nor would it have been obvious to one of ordinary skill in the art at the time of invention to modify the ligands of the prior art in order to arrive at those of the instant invention. There is no motivation to do so.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: *Phosphorus and Sulfur and the Related Elements* (1983), 15(3), p. 331-49 (CAPLUS abstract) is cited to show related compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 **BRIAN DAVIS**  
**PRIMARY EXAMINER**

Brian J. Davis  
October 4, 2004